

REMARKS

I. Pending Claims

Claims 1, 11, 12 and 29-45 are currently pending. Claims 2-10, 13-28, and 46-57 were canceled upon filing of the Divisional Application on February 5, 2002. Claims 1, 12, 29, 30, 33, 35, 44 and 45 have been withdrawn from consideration. Claims 11, 31, 32, 34, and 36-43 are under active consideration. The Examiner acknowledged Applicants' amendment of claims 11 and 39 in the response filed June 11, 2003.

Applicants thank the Examiner for his comments over the phone on Tuesday, September 23, 2003 indicating that the rejection under 35 U.S.C. § 112, first paragraph would be overcome upon entry of a functional limitation to claim 11. Currently, Applicants request entry of the amendment to claim 11, which addresses the written description and enablement rejections under 35 U.S.C. § 112, first paragraph. Applicants expressly do not disclaim the subject matter of any invention disclosed herein which is not set forth in the instantly filed claims. Applicants reserve the right to prosecute the non-elected claims in subsequent divisional applications.

II. Support for the Amendments

Part b) of claim 11 has been amended to recite, "...a polypeptide comprising a naturally occurring amino acid sequence at least 90% identical to the amino acid sequence of SEQ ID NO:1, said polypeptide having protein phosphatase activity."

Support for this amendment may be found in the Specification, at least, at page 14, lines 1-4, wherein it is set forth that a preferred PROPHO variant is one having at least 80%, and more preferably 90%, amino acid sequence identity to the PROPHO amino acid sequence (SEQ ID NO:1), and retains the biological, immunological or other functional characteristics of the activity of PROPHO.

Applicants are amending claim 11 at this time merely to expedite the allowance of the instant application. However, Applicants reserve the right to argue the full scope of the equivalents in subsequent continuation applications.

Applicants have also revised the Specification at page 14, lines 1-4, to correct an obvious error. No new matter has been added by these amendments.

III. Declaration

The Examiner indicated that the declaration is defective because the citizenship of Olga Bandman was not listed. Applicants submit herewith a newly executed copy of the declaration, which designates the citizenship of Olga Bandman.

IV. Claim Objections

The Examiner has objected to claims 36-41 as being dependent upon a rejected base claim. The Examiner has stated that claims 36-41 would appear to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have not amended claims 36-41 to incorporate all limitations of claim 11. Instead, Applicants have amended claim 11 to add a functional limitation, which clarifies the subject matter claimed. As such, the amendment should render moot the rejection of claim 11 under 35 U.S.C. § 112, first paragraph.

Withdrawal of this objection is therefore respectfully requested.

V. Claim Rejections – 35 U.S.C. § 112, First Paragraph, Written Description

Claims 11, 31, 32, 34, 42, and 43 were rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which allegedly fails to reasonably convey to one of skill in the art that the Applicants had possession of the claimed invention at the time the application was filed. Specifically, the Examiner stated that “...the disclosure of the single representative species of an antibody that binds SEQ ID NO:1 is insufficient to be representative of the attributes and features of *all* species encompassed by the claimed genus,” (Final Office Action; August 26, 2003, page 4, emphasis in original).

Please note that Applicants have amended claim 11 to recite that the polypeptide comprising a naturally occurring amino acid sequence at least 90% identical to the amino acid sequence of SEQ ID NO:1 **has protein phosphatase activity**. The addition of this functional limitation clarifies the claimed subject matter. Applicants continue to traverse this rejection for the reasons made of record in the response to the Office Action of February 7, 2003. For at least these reasons, Applicants respectfully request withdrawal of the written description rejection under 35 U.S.C. § 112, first paragraph.

VI. Claim Rejections – 35 U.S.C. § 112, First Paragraph, Enablement

The Examiner has maintained the rejection of claims 11, 31, 32, 34, 42, and 43 under 35 U.S.C. § 112, first paragraph, for the reasons of record (Final Office Action; August 26, 2003, page 9). Applicants traverse the rejection for the reasons made of record in the response to the Office Action of February 7, 2003.

Specifically, the Examiner has asserted that “the claims are so broad as to encompass *all* antibodies that bind *all* polypeptides comprising a naturally-occurring amino acid sequence that is at least 90% identical to SEQ ID NO:1” (Final Office Action; August 26, 2003, page 10, emphasis in original).

Please note that Applicants have amended claim 11 to recite that the polypeptide comprising a naturally occurring amino acid sequence at least 90% identical to the amino acid sequence of SEQ ID NO:1 **has protein phosphatase activity**. The addition of this functional limitation clarifies the claimed subject matter. Applicants continue to traverse this rejection for the reasons made of record in the response to the Office Action of February 7, 2003. For at least the above reasons, withdrawal of the enablement rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding objections/rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

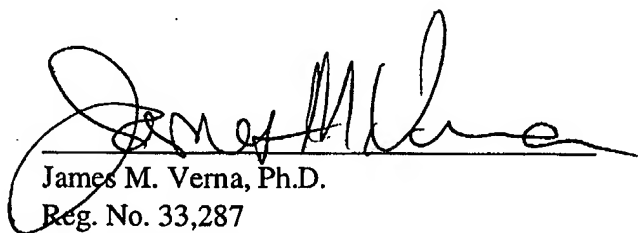
Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE CORPORATION

Date:

October 24, 2003


James M. Verna, Ph.D.

Reg. No. 33,287

Direct Dial Telephone: (650) 845-5415

Date: October 24, 2003


Gina C. Nellesen

Reg. No. 52,062

Direct Dial Telephone: (650) 843-7342

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886